

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**2007-1091
(Serial No. 09/910,654)**

IN RE RODGER BURROWS

**Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences**

REPLY BRIEF OF APPELLANT RODGER BURROWS

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May 22, 2007

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Burrows

No. 2007-1091

CERTIFICATE OF INTEREST

Counsel for the Appellant certifies the following:

1. The full name of every party or amicus represented by me is Rodger Burrows
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: N/A
3. All parent corporations and any publicly held companies that own 10% or more of the stock of the party or amicus represented by me are: None
4. There is no such corporation listed in paragraph 3.
5. The name of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Richard M. Saccocio, P.A.

Richard M. Saccocio, Esq.

Date:

May 21, 2007

Signature of Counsel

Richard M. Saccocio

Name of Counsel

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APPELLANT'S REPLY ARGUMENTS

I. THE DIRECTOR'S STATEMENT OF THE ISSUE

One fundamental principle that was imparted to me in law school was 'let me frame the issue and I will win every case'. Apparently, the Solicitor for the Director practices this principle. The issue framed by the Director is not the issue herein but rather is one of faulted argument, (D.Br. P. 1).

The patent application was rejected under 35 USC § 103. The reasoning behind the § 103 rejection is in dispute. The Director however has framed the issue in accordance with his later argued reasons and not in accordance with *Graham v. John Deer Co*, 383 U.S. 1 "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims art issue are to be ascertained; and, the level of ordinary skill in the pertinent art are resolved". The Director's phrasing of the issue and his arguments pays little heed to such dictates.

The Director states that the artisan in the present case is familiar with conventional airline ticket issuing techniques, namely computer generation and printing, (D.Br. p.1). The use of the word "namely" positively recites that computer generation [?] is within the knowledge of any person that is familiar with computer technique. If this is true, every user of a computer has a high level of skill in computer generation. Not only is the term "computer generation" not

defined, the Director makes no attempt to provide support for this extreme extrapolation. On the other hand, as shown below, the ordinary travel agent has little or no skill in the field of "computer generation".

II THE DIRECTOR'S STATEMENT OF THE CASE

Applicant respectfully disagrees with the Director's Statement Of The Case, which makes it appear that Appellant has taken two bites of the apple. In the initial rejection of the application, the Examiner relied on Friedes '966 (A 134-137), in combination with ARC's Industry Agent's Handbook (IAH Sec. 70.0, A 079). Notwithstanding that the IAH repeatedly referred to saving the image of the agent coupon and only once mentioned coupon data, the Examiner insisted that the 'data' language prevailed (A 133-134). Appellant rebutted the rejection by showing that Friedes was not relevant prior art and that the teaching of the ARC Handbook and documents was directed to images rather than data. Such was the basis of the first appeal by Appellant.

In the first appeal, the Board overturned the Examiner as regards the Friedes reference and agreed with Appellant that the ARC documents taken as a whole were directed to images and not data. However, the Board issued a new ground of rejection under § 103 surprisingly based on the IAH documents in view of the prior art of fax machines, check imaging by banks and multi task computing. (A

294-306). However, Appellant realized that the Board did not fully understand his contribution to the art which resulted in the Board mischaracterizing Appellant's invention as simply saving the data contained within the standard travel agent reservation system and comparing it to the fax machine art and bank checks art. In response, Appellant reopened prosecution and submitted arguments and evidence regarding the new ground of rejection and the mischaracterization (A 309-361). Part of the new evidence comprised a declaration by Appellant (A 333-337) detailing the errors in the mischaracterization, detailing his extensive computer skills, the low level of computer skills of ordinary travel agents, and the unique efforts of appellant in conceiving and developing his claimed invention, which in part involved a prior computer effort of Appellant (known only to him) in combination with a unique approach emulating a printer. The Appellants approach was so unique he had to use a number of computer experts each having only a part of his solution, (A 333-337). As expected, the Examiner repeated the Board's new basis and rejected the application. Appellant's second appeal followed (A 360-361). Thus, the second appeal was with regard to different issues than the first appeal, primarily the inapplicability of the Board's "prior art" and the Board's mischaracterization of Appellant's invention. Thus, Appellant's first and second appeals to the Board did not comprise the Appellant taking a second bite of the apple.

III. THE DIRECTOR'S STATEMENT OF THE FACTS

Appellant respectfully disagrees with the Director's Statement Of The facts in at least one very important aspect. The Director' states "in Burrows' claimed invention, rather than saving the hard copy, the agent coupon data is saved, retrieved and printed (D. Br. p. 4). The Director's statement is an extreme oversimplification and presumes that the agent coupon data exists and is capable of being saved. This is not true. The first element of Appellant's claim 1 is : "generating agent coupon data simultaneously with the printing of the airline ticket". That the Director incorrectly assumes that the coupon data already exists as a separate is a major misstatement of the facts and results in the erroneous conclusion that the coupon data is capable of being saved. However, before Appellant addresses this aspect, it is believed that for purposes of organization of this brief, the level of skill of the ordinary travel agent is to be first addressed.

IV. THE DIRECTOR'S STATEMENT OF THE LEVEL OF ORDINARY SKILL

The Director states that the ordinary artisan is familiar with conventional airline ticket issuing techniques, namely computer generation and printing (D. Br. P.1). Appellant submits that there is absolutely no basis for such a bold statement.

The artisan involved in the travel agent business is of course the travel agent. In this regard, under *Graham*, it is the Director's burden to determine and

demonstrate the level of computer skills of an ordinary travel agent. The Director's brief does not do so. In Appellant's declaration (A 334) it is stated that "the level of computer skills of the ordinary travel agent is quite low and therefore an ordinary travel agent would not have been able to even think of my invention let alone consider it obvious." It is to be noted that the Director did not dispute this statement or present any evidence to the contrary.

Even though it is not necessary for Appellant to present rebut the Director's failure to substantiate his statement of the advanced computer generation skills of travel agents, there are facts in the record supporting the low level of skill of the ordinary travel agent. In the 2005 ARC agency handbook, section, 70.0, ARC stated that that ARC agents are trained professionals and are equipped to assist travel agents with improved record keeping techniques (A 326); travel agents are required to provide written notice to and receive written approval by ARC to maintain the required documents on microfiche/film or on an optical storage medium (A 326), (other than Applicant, the record shows that not one travel agent submitted an application for approval(A 087), thus no travel agent applied for the simplistic solution of scanning the coupon and saving the scanned image). In the press release of 10/27/00 ARC reported that it had created an IAR training program to provide agents with the ability to implement the optical storage (A 075). However, ARC made it exceptionally clear that that the travel agents had to exhibit

the ability to store images of the coupons and not the data of the agent coupons.

Since travel agents had to be trained to be able to scan or photograph a document and then save the image on a CD Rom, it is not reasonable to state that they had any "computer generation" [?] skills.

In accordance with the above it must be concluded that ordinary travel agents do not have the computer generating [?] and printing skills as alleged by the Director. To say that the ordinary travel agent is knowledgeable about the IAH and then conclude this involves computer skills involves a leap of faith which Appellant deems is unwarranted. Indeed there is nothing in the record to indicate that the ordinary travel agent possesses any computer skills.

V. THE TEACHINGS OF THE PRIOR ART

It is respectfully submitted that the disclosures of ARC and the computer examples (fax machines, bank checks , etc.) do not comprise prior art.

It is to be noted that the Director's brief makes no attempt to use these prior art references as suggesting or teaching data transmission as did the Board. Rather, the Director states that the fax and multimedia references were used by the Board to support its finding that electronic storage and transmission of image data was well known in the art (D. Br. 11). In essence, the Director has backed away from the Board's reliance on fax transmissions and bank check image transmissions as

teaching the data transmissions claimed by Appellant. But, a review of the Board's decision is not as the Director states. The Board relied on the fax images and the bank check images as containing data (0482) and concluded that it would be obvious to store the data electronically because ARC already taught that the coupon data could be stored in image form. The fallacy of both the Director's and the Board's different arguments is that the Board and the Director assume that that "When an airline ticket is printed, the data associated with that ticket must have been simultaneously generated in order to print the airline ticket" (A482).

This fallacy comprises the unwarranted assumption that the coupon data is being generated by the reservation system. The coupon data does not exist as data in the reservation system. In the application it is stated that an appropriate software program is loaded into the data storage apparatus which enables communication between the reservation system and the data storage system, and that in accordance with the software program the coupon data is simultaneously generated along with the airline ticket (A036). The word "generated" is the key meaning that it did not previously exist and had to be created. This language is consistent with Appellant's declaration where it is stated "I decided the best way to solve the problem was to generate the agent coupon data while the airline ticket was being printed, extract the generated data and then operate on the generated and separated data so as to be able to store and identify individual agent coupon data

from the many..." (A 334) . In plain language, the coupon data did not exist in the reservation system and it was therefore necessary to devise a way to generate and separate the coupon data from the reservation system that only produced printed images. The definition of "data" in accordance with the Class Definition for Class 715-DATA PROCESSING published by the U.S. Patent office is DATA:

"representation of information in a coded manner suitable for communication, interpretation or processing." The information printed by the reservation system, being in the form of images, cannot be communicated, interpreted, or processed. For example, the name of the passenger on the coupon cannot be extracted from the image, it simply forms part of the image that cannot be independently communicated, interpreted or processed and cannot therefore comprise data as defined by the Patent Office. As another example, when an image of a processed bank check is brought up on a screen, none of the information on the image can be extracted, or processed. In view of these facts, the Director's support of the Board's finding of "inherent generation" of the coupon data cannot stand.

Providing the coupon data with an identifier as per claim 1 is another limiting element overcoming the finding of obviousness, for example, the passenger's name can be extracted from the generated and transmitted data and used to identify that particular coupon data. Clearly outlined in the specification is a description of a data storage method. The slashes represent the storage of the

coupon data file in an arrangement consisting of ARC Number/Sales Ending Date/image file. The actual identifier of the individual coupon file is the ticket number, passenger name and passenger record locator. So for the file to arrive at the location on the hard drive it would have had to have the ARC number extracted. It would have had to have the Issue Date extracted and the Sales End date would have of necessity had to have been computed. Because the IAH is concerned with images and not data, and the information on the image cannot be extracted or processed as data, it cannot be said that the ARC documents teach or suggest this claim limitation. Because Appellant referred to the data saving file, in part as an image file is no admission that the image is saved. The specification clearly shows otherwise. In fact, it is rather sophomoric for the Director to make this argument. Calling the file an image file was simply a matter of choice which allows the operator to quickly associate the coupon data with the image that is later printed. Any file designation could have been used, but it would not change the fact that data was being stored as stated in the application.

The Director and the Board use the term "image data" to support the obviousness rejection by stating it was well known to store and transmit image data. The Class definition for Class 715 defines "image data" as being "the information provided to form the visual image." The standard reservation system does not store a visual image, it only prints a copy of the coupon. The reservation

system is not capable of storing a visual image. If the reservation system was capable of producing and saving a visual image of the coupon, there would have been no need for ARC's numerous statements regarding optically saving the image of the coupon because it already existed. Appellant's invention does not claim the transmission and storage of image data, it claims the transmission and storage of the data generated as limited in the first element of claim 1. Moreover, in an obviousness analysis, one must look to the claim as a whole. And, even though one or more elements of a combination claim are known in the prior art, it does not follow that the entire claim is obvious. *Custom Accessories Inc. v. Jeffery-Allan Industries, Inc.* 807 F. 2d. 955 (Fed. Cir. 1986), casting an invention as a combination of old elements improperly leads to an analysis of the claimed invention by parts, not by the whole. The prior art does not suggest or teach the generation of coupon data from the stream of information that is capable only of printing a coupon.

VI. THE TEACHINGS OF THE ARC DOCUMENTS.

Great emphasis is placed on the ARC documents that provide for optical storage of the agent coupons as obviating the storage of coupon data as claimed by Appellant because an image can also convey data. (A483). Certainly, one can read data from an optical image; but that is not what Appellant is claiming. Appellant is

claiming the transmission of the generated coupon data and not the “conveying “of data from an optical image. As shown above the data on an optical image cannot be transmitted as per the Patent Office’s own definition of data. But, there is more.

That the ARC documents cannot be said to render obvious Appellant’s claim of generating coupon data, identifying it, storing it and then be able to later retrieve it, is shown by the very same ARC documents. While ARC insisted that the travel agents optically save images of the coupons so that the paper coupons could be discarded, and that “If you’re using a type of optical storage media, we’re are talking about capturing the image of the coupon, not creating a data base” Travel News Weekly (6/20/2000) (A 170-171), ARC itself was attempting to develop a data base of coupon data.

Interestingly, while ARC strictly prohibited the travel agents to store coupon data, ARC itself, on November 2, 2000 announced that “In the long run, ARC will develop the ability to **produce agent coupons on demand from ARC’s data warehouse**, (emphasis supplied), (A 086). In early 2000, ARC stated that “ARC is in the design phase of a central storage facility that will eliminate the requirement for travel agents to store agent coupons (this admission by ARC that it was developing its own data base system that did not involve optical storage of agent coupons, should alone negate all of the Director’s arguments that the ARC documents allowing optical storage taught or suggested Appellant’s unique method

of generating, identifying, and saving coupon data). As of 05/31/200 ARC still had still not developed its alleged data (not image) storage system (A 169). In a document dated after January 31, 2001, ARC stated that it is still developing its own data storage system which is scheduled for completion "during the fourth quarter of this year" (A 092). However, in the same document ARC stated that it had approved Applicant's invention on January 30, 2001 (A 092). Thus, ARC's scheduled completion date had to be in the fourth quarter of 2001-notwithstanding Appellant's data system was shown to and approved by ARC almost one full year earlier. Since ARC had actually embarked upon a data base system to eliminate coupon storage (optically or otherwise) and had not developed it at the time of Appellant's application, how can it be said to obviate Appellant's invention by teaching or suggesting the same? It cannot.

VII. INTRODUCING NEW ARGUMENTS

The Director correctly states that claim construction is de novo reviewable on appeal and comprises an element when considering obviousness. But under this principle, the claims must be construed. Applicant questions what claim language was disputed by the Board and given an interpretation. In actuality, the claim interpretation in question is a product of the Director and not in the record. Thus, all of the Director's arguments regarding the claim interpretation were made in

order for the Director to bolster the Board's erroneous finding of obviousness and to encompass the otherwise inapplicable prior art into Appellant's claims. The filing cabinet/ computer storage claim interpretation is one such example that is a new and impermissible argument. Similarly, the Director's argument regarding the term "comprising" goes on to explain and detailedly argues that the claim includes saving an image. This is a new argument that is inappropriately being made. The Director may not make new arguments in support of the Board's decision. Moreover, Applicant submits that the Director's claim interpretation is overly broad and not in conformance with the details stated in the specification which is required per *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). In accordance with the entire file wrapper and the specification, it is submitted that Appellant's claimed invention is specific and appropriately narrow. The Board's decisions do not involve the question of claim interpretation. That question is strictly an impermissible argument of the Director, but in view of the fact that the Director's interpretation did not include the specification, the same is a species argument not requiring remand to the Board.

VIII. TEACHING AWAY

In the Director's final argument that ARC does not teach away from claim 1, he conditions his argument on the different forms of storage that may be used to

store images, (D. Br. P. 26). ARC absolutely taught the optical storage of coupon images; however, Appellant claims the storage of data not images. This is a distinction with a difference. Applicant cannot imagine a more strongly worded statement by ARC "that we are not talking about creating a database" with anything other than ARC was teaching away from applicant's invention of creating a data base. Teaching away exists when a person of ordinary skill, upon reading the reference, would be discouraged from following the path or would be led in a direction divergent from the path taken by the applicant, *In re Gurley*, 27 F.3d, 551 (Fed. Cir. 1994).

Clearly, ARC suggested that the travel agents optically save images of the agent coupons and that saving the coupon data was not satisfactory and not to be done. See *Kloster Speedsteel AB v. Crucible, Inc.* 793 F.2d 1565 (Fed. Cir. 1986). Doing what those skilled in the art should not be done is strongly probative of nonobviousness

IX. THE INVENTION MUST BE VIEWED AS A WHOLE.

In determining obviousness under § 103 the statute requires that "the subject matter as a whole would have been obvious at the time the invention was made..." Indeed, the law is clear that new combinations of existing principles or features are patentable, and that "as a whole" in title 35 prevents evaluation of the invention

part by parts. Moreover, hindsight reasoning using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features in a new way to achieve a new result-often the very definition of invention, and such hindsight is precluded under §103 by requiring assessment as a whole. *Ruiz v. A.B. Chance Co.* 357 F3d 12370 (Fed. Cir. 2004).

In determining whether the invention as a whole would have been obvious under §103, we must first delineate the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter and disclosed on the specification..." *In re Antoine*, 559 F.2d 618, (CCPA 1977).

In applying the recited law to Applicant's invention, it is abundantly clear that the claims of Applicant's application as a whole claims the new result of completely eliminating the storage of images of agent coupons in any form. No such result existed at the time of applicant's invention. To say Applicant's invention is obvious under §103 requires hindsight using applicant's invention as a roadmap.

X. CONCLUSION

Appellant has made a significant contribution to the art of travel agent reservation systems that was approved by ARC and does not require optical storage. Accordingly, Appellant's invention is not obvious under § 103. Appellant respectfully requests this Court to overturn the Board's decision of obviousness.

Dated May 21, 2007

Respectfully submitted,

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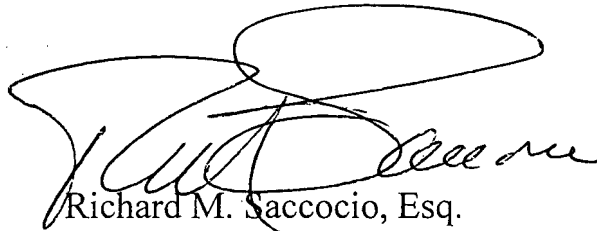
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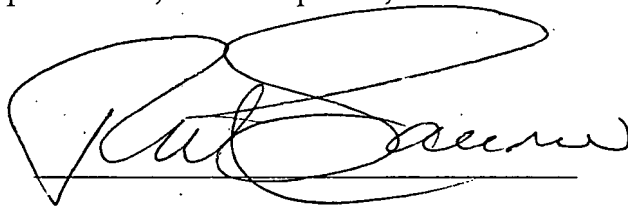
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